REMARKS

I. Status of the Claims

Claims 1-99 are pending in this application. Independent claims 1 and 51 are amended herein to clarify that the fluorescent dye is present in an amount sufficient to dye keratin materials with a lightening effect. Support for this amendment can be found in the original specification and claims, and thus it does not raise any issues of new matter.

II. Allowable Subject Matter

Applicants thank the Examiner for indicating the allowable subject matter of claims 7-50, 57-99. However, Applicants maintain that the remaining pending claims are also patentable for at least the reasons set forth below, and therefore wish to continue prosecution of all the pending claims in this application at this time.

III. Rejection under 35 U.S.C. § 102(b)

The Examiner has rejected claims 51-56 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,256,458 to Degen et al. ("Degen") for the reasons disclosed at page 5 of the present Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

In order to anticipate the claimed invention, a reference must "teach every aspect of the claimed invention either explicitly or impliedly." M.P.E.P. § 706.02. Further, the reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing and combining various disclosures." *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972). Importantly, the absence of a single element or limitation indicates the reference neither

describes nor anticipates the claim. M.P.E.P. § 2131. Therefore, a rejection under § 102(b) is proper only when the claimed subject matter is identically described or disclosed in a single prior art reference. *In re Arkley*, 455 F.2d at 587.

Degen teaches methine dyes for dyeing paper and anionically modified fibers. Degen does not, however, teach a composition comprising, in a cosmetically acceptable medium, at least one fluorescent dye present in an amount sufficient to dye keratin materials with a lightening effect. *See* present amended claim 51. More specifically, Degen does not teach the dye being present in a composition in an amount sufficient to dye keratin materials with a lightening effect. In fact, the dyeing of keratin materials, let alone with a lightening effect, is not taught or suggested in any way by Degen. Because Degen does not teach every aspect of the claimed invention, Degen fails to anticipate the present disclosure.

Accordingly, with respect to claims 51-56, Applicants submit that the Examiner has failed to demonstrate that the rejected claims are anticipated by Degen, and therefore request that the § 102(b) rejection be withdrawn.

IV. Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Degen for the reasons disclosed at page 5-6 of the present Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

In order to establish a *prima facie* case of obviousness, the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." *See In re Fine*, 837, F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Specifically,

the Examiner must meet three basic criteria. First, the prior art references, taken alone or in combination, must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. And finally, there must be a reasonable expectation of success. *See* M.P.E.P. §§ 2143.01-03. In the present case, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

As argued above, Degen teaches methine dyes for dyeing paper and anionically modified fibers. However, Degen does not teach or suggest a process for dyeing human keratin materials, let alone such a process for dyeing with lightening effect. Further, he does not teach or suggest carrying out such a process with a composition comprising, in a cosmetically acceptable medium, a fluorescent dye present in an amount sufficient to dye keratin materials with a lightening effect. Thus, Degen does not provide any motivation to one of skill in the art to use his dye, in a cosmetically acceptable medium, to dye human keratin material. Further, even if one of skill in the art did, for the sake of argument, use the methine dyes disclosed in Degen, in a cosmetically acceptable medium, to dye human keratin fibers, there could not possibly have been a reasonable expectation of success based on Degen's disclosure alone.

Accordingly, with respect to claims 1-6, Applicants submit that the Examiner has failed to demonstrate that the rejected claims are obvious in view of Degen, and therefore request that the § 103(a) rejection be withdrawn.

V. Rejection based on Obviousness-Type Double Patenting

The Examiner has rejected claims 1-6 and 51-56 on the basis of non-statutory double patenting over 11 co-pending applications as set forth on pages 2-4 of the present Office Action. Applicants disagree with the rejections but respectfully request the Examiner to hold the rejections in abeyance for the time being. Once the Examiner has considered the arguments above, which Applicants believe put claims 1-6 and 51-56 in condition for allowance, Applicants will consider filing a Terminal Disclaimer over the co-pending applications. The Examiner is welcome to call the undersigned to advance prosecution on this point more quickly via a telephone conference.

VI. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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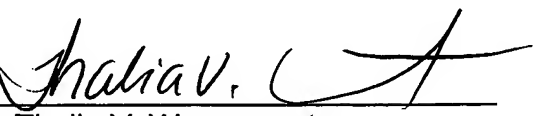
By: 
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